



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,223	05/30/2001	Doreen Lynn Galli	RSW920010033US1	8092

30449 7590 01/09/2008
SCHMEISER, OLSEN & WATTS
22 CENTURY HILL DRIVE
SUITE 302
LATHAM, NY 12110

EXAMINER

KANG, INSUN

ART UNIT	PAPER NUMBER
----------	--------------

2193

MAIL DATE	DELIVERY MODE
-----------	---------------

01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/870,223

Applicant(s)

GALLI, DOREEN LYNN

Examiner

Insun Kang

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 14, 15, 17-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 14, 15, 17-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the RCE amendment filed on 10/31//2007.
2. As per applicant's request, claim 21 has been canceled, claims 9 and 18 have been amended. Claims 9, 14, 15, 17-20 and 22-25 are pending in the application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14, 15, 17, and 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 14, 15, 17, and 22-25 are non-statutory because they merely describe the contents of the data stored in the voice prompt database. Because these data contents do not further limit the claimed invention either functionally or structurally, they essentially constitute non-functional descriptive materials that are not capable of producing a useful result, and hence represent only abstract ideas. Therefore, the claims are non-statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

Per claim 9:

Osder discloses: a method for selecting a voice prompt ...the method comprising the steps of:

- receiving commands from a telephone caller (i.e. "VMMM 32 assigns NAP Message IDs to received and recorded voice messages and via AIM 30 returns these voice Message IDs to the application involved in the telephone call," col. 8 lines 1-7); responsive to said received commands, determining that the voice prompt is needed (i.e. "When a Network Application 10 requires that a prompt to be played," col. 7 lines 41-42);
- responsive to said determining that voice prompt is needed, providing a variable identified with a function of the voice prompt (i.e. the SPIN application table 1 in Fig 3 assigns the values of the Ids (variable) such as UV10AE etc to point to the prompt element sets such as the tables 2-5 containing the pre-recorded prompts in SPINDB)
- assigning a first value to the variable by accessing an assignment table that is held outside the compiled code of the application program (i.e. A SPIN Application table 1 in Fig 3 lists the SPIN applications 1 to N with SPIN application Ids (identifiers) for American English, Spanish, Dutch, etc (Osder, see Fig 3). For example, the ID, "UV10AE," in column 1 identifies American English. These SPIN application IDs designate "a set of prompts and their related entities in the SPIN database and in the Voice File," Osder, col. 28 lines 30-32; The tables in SPIN database are held outside of

the Network Application and therefore, the meta-language variables to the tables are read from outside of the Network Application, Osder, col. 3 lines 48-51; col. 27 lines 27-41)

- identifying a first database record that includes a digitally encoded voice prompt consisting of the first sequence of bits wherein the bits of the first sequence of bits are stored contiguously in the identified first database record, and consisting of a first bit pattern that consists of a first contiguous sequence of bits wherein said identifying the first database record is implemented through use of the first value which selects the first database record and specifies the first bit pattern; reading the identified first database record (i.e. the ID, "UV10AE," in column 1 identifies American English in Fig 3. These SPIN application IDs designate "a set of prompts and their related entities in the SPIN database and in the Voice File (Osder, col. 28 lines 30-32)." The SPIN application ID, "UV10AE" "provides a unique identifier that represents both the set of prompts that a Network Application can play and a specific language," Osder, col. 28 lines 32-37; The NAP Message Ids corresponding to the recorded voice elements are stored in a SPIN Data Base (SPINDB)," col. 3 lines 48-60; "The Message ID fields are generally utilized to speak user recorded information such as the user's recorded name or personal greeting," col. 12 lines 59-61; "Every static and dynamic element of a SPIN application is recorded in table 80," col. 10 lines 6-10)

- passing the first bit pattern from the first database record that had been read to an audio apparatus ("The voice for the elements can be recorded through NAP and stored in the NAP voice file," col. 3 lines 48-61; "The Network Application issues a PEP command to send a prompt," col. 4 lines 5-25; col. 6 lines 11-31)

- performing, by the audio apparatus, a digital-to-analog conversion of the first bit pattern that had been passed to the audio apparatus (i.e. The NAP is a digital platform storing the voice prompts in SPINDB as a digital format and converting them to speech when the Network application invokes playing of the prompts (col. 5 lines 42-56)
- speaking, by the audio apparatus, a first message to a telephone caller, said first message consisting of the digital-to-analog converted first bit pattern (i.e. “you have five new messages,” col. 5 lines 42-56).

Per claim 18:

Osder further discloses:

- assigning a second value to the variable by accessing the assignment table, wherein the second value of the variable differs from the first value of the variable (i.e. A SPIN Application table 1 in Fig 3 lists the SPIN applications 1 to N with SPIN application Ids (identifiers) for American English, Spanish, Dutch, etc (Osder, see Fig 3). For example, the ID, “UV10AE,” in column 1 identifies American English. These SPIN application IDs designate “a set of prompts and their related entities in the SPIN database and in the Voice File,” Osder, col. 28 lines 30-32; The tables in SPIN database are held outside of the Network Application and therefore, the meta-language variables to the tables are read from outside of the Network Application, Osder, col. 3 lines 48-51; col. 27 lines 27-41)
- replacing the first value of the variable in the assignment table with the assigned second value of the variable (i.e. col. 3 lines 64- col. 4 lines 1-5).

- identifying a second database record that includes a digitally encoded voice prompt consisting of a second bit pattern that consists of a second sequence of bits wherein the bits of the first sequence of bits are stored contiguously in the identified first database record (i.e. "The Message ID fields are generally utilized to speak user recorded information such as the user's recorded name or personal greeting," col. 12 lines 59-61; "Every static and dynamic element of a SPIN application is recorded in table 80," col. 10 lines 6-10)
- wherein the second bit pattern differs from the first bit pattern, and wherein said identifying the second database record is implemented through use of the second value which selects the second database record and specifies the second bit pattern; reading the second database record; (i.e. the ID, "UV10AE," in column 1 identifies American English in Fig 3. These SPIN application IDs designate "a set of prompts and their related entities in the SPIN database and in the Voice File (Osder, col. 28 lines 30-32)." The SPIN application ID, "UV10AE" "provides a unique identifier that represents both the set of prompts that a Network Application can play and a specific language," Osder, col. 28 lines 32-37; The NAP Message Ids corresponding to the recorded voice elements are stored in a SPIN Data Base (SPINDB)," col. 3 lines 48-60)
- passing the second bit pattern from the second database record that had been read to the audio apparatus ("The voice for the elements can be recorded through NAP and stored in the NAP voice file," col. 3 lines 48-61; "The Network Application issues a PEP command to send a prompt," col. 4 lines 5-25; col. 6 lines 11-31)

- performing, by the audio apparatus, a digital-to-analog conversion of the second bit pattern that had been passed to the audio apparatus (i.e. The NAP is a digital platform storing the voice prompts in SPINDB as a digital format and converting them to speech when the Network application invokes playing of the prompts (col. 5 lines 42-56)
- speaking, by the audio apparatus, a second message to a telephone caller, said second message consisting of the digital-to-analog converted second bit pattern (i.e. “you have five new messages,” col. 5 lines 42-56).

Per claim 19:

Osder further discloses: wherein said assigning the second value and said replacing the first value with the second value are performed by an interactive voice response (IVR) system administrator (i.e. col. 3 lines 64- col. 4 lines 1-5).

Per claim 20:

Osder further discloses: wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special IVR programming skill to replace the first value with the second value (i.e. col. 3 lines 64- col. 4 lines 1-5, 33-37).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14, 15, 17, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

Per claim 14:

Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of music wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said music. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.

Per claim 15:

Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of audio tone wherein said speaking the first message comprises speaking

the first message consisting of the digital-to-analog converted first bit pattern as said audio tone. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include audio tone of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.

Per claim 17:

Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of a sequence of beeps wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said a sequence of beeps. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including beeps as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.

Per claim 22:

Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; wherein said speaking the first message comprises speaking by the first speaker the first

message ... wherein said speaking the second message comprises speaking by the second speaker the second message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by different speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different purposes.

Per claim 23:

Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a male speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a female speaker; wherein said speaking the first message comprises speaking by the male speaker the first message ... wherein said speaking the second message comprises speaking by the female speaker the second message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by male and female speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.

Per claim 24:

Osder does not explicitly teach the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first message ...second message consisting of the digital-to-analog converted second bit pattern having the second level of formality. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different level of formality of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.

Per claim 25:

Osder does not explicitly teach that the voice prompt pertaining...spoken by a speaker in a first wording and conveys a meaning...second wording that differs from the first wording and conveys said meaning...in the first wording that conveys said meaning...second bit pattern in the second wording that conveys said meaning. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including a dialect as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.

Response to Arguments

9. Applicant's arguments filed on 10/31/2007 have been fully considered but they are not persuasive.

1) The applicant states that: Although Osder teaches determining that the voice prompt is needed, Osder does not teach determining that the voice prompt is needed in response to commands received from the telephone caller (remark, 9).

In response, Osder also discloses a voice interactive system where prompts are played based on communication between a caller and the system through commands. When a caller requests to play a voice message or to access the system, a prompt such as "you have five new messages" or a personal greeting/user name is played (i.e. col. 5 lines 54-56; col. 12 lines 59-61). The examiner investigated the whole specification and it recites, "when a voice prompt is needed" in pages 6-7. Osder clearly states, "When a Network Application 10 requires that a prompt to be played" in col. 7 lines 41-42.

2) The Applicant continues to argue that in Osder, by being required to perform said assembling step, it is logically impossible for Osder to teach that the content of the spoken message at runtime consists of the digital-to-analog converted first bit pattern existing in the first database record as recited in claim 9. The static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the first database record. Osder does not teach that the bits of the bit pattern "you have five new messages" is stored contiguously in a first database record prior to the digital-to-analog conversion (remark, 10-11).

In response, the applicant appears to use the term “contiguously” in place of the term “static” which had previously used. Some reasonable interpretation of the term contiguously can be applied. First, although the applicant uses the exemplary prompt “you have five new messages” found in Osder for his argument, it is noted that the prompt is only one example given in Osder’s voice response system. Even in this exemplary prompt, “you,” for example, can be considered as a first bit pattern existing in the first database record where each bits of “you” is stored contiguously prior to the conversion. Second, in response to the applicant’s argument that the “static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the first database record (remark, 11),” it is noted that Osder states that every static and dynamic element of a SPIN application is recorded in the cache element table 80 (col. 10, lines 6-9; see, fig 5A). Third, Osder states user’s recorded name or personal greeting which are contiguously stored. Therefore, applicant’s argument is not persuasive.

3)Applicants assert that a user is not a system administrator and the IVR system administrator does not use special IVR programming skill to replace the first value with the second value (remark, 12-13).

First, Osder discloses the SPIN Administration Facility 40 (i.e. col. 16 lines 43-45). The person who uses the facility is a system administrator. Second, an administrator is a user who can manage an operation of a system or a specific project. Certainly a user can be a system administrator of his/her own system or program. Osder states that the “SPIN user can copy and modify an existing SPIN application for one spoken language to provide another SPIN application for another spoken language (i.e. col. 3, line 67-col. 4

lines 1-4).” If a user can modify or utilize the system, the user is considered to have an administrator role. Furthermore, the IVR user does not need to alter the “functional code of the Network Application nor the operational code of the underlying PEP (i.e. col. 4 lines 33-37). No “special IVR programming skill” is required to use the SPIN screen.

4) Per claims 14, 15, 17, and 22-25:

These claims are directed to the same subject matters that had been addressed previously. Therefore, the same arguments are not necessary to present. See the previous office actions and the decision made by the BOAI on 2/21/2007.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 571-272-3724. The examiner can normally be reached on M-F 8:30-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, MENG AI AN can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Application/Control Number:

09/870,223

Art Unit: 2193

Page 15

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IK

AU 2193

A handwritten signature in black ink, consisting of a stylized, cursive script that begins with a large, looped 'C' and ends with a long, horizontal stroke.